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WOOD, PHILLIPS, VAN SANTEN, CLARK & MORTIMER
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| EXAMINER |
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GART, MATTHEW S

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| ART UNIT | PAPER NUMBER |
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3625

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 02/14/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/833,305

Applicant(s)

KRONENBERGER, ROBERT A.

Examiner

Matthew S. Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10, 14-20 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10, 14-20 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Prosecution History Summary

Claims 1, 2, 11-13, 21, and 22 have been cancelled.

Claims 3-10, 14-20 and 23-25 are pending.

An action on the merits follows.

Response to Amendment

The rejection of claims 3-10, 14-20 and 23-25 rejected under 35 U.S.C. 112, second paragraph is vacated in view of the Applicant's amendment filed on 12/08/2006.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 6-8, 10, 19, 20, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin (US 2005/0131571 A1) in view of Berger et al. (U.S. Patent No. 6,414,693 B1).

Costin discloses a method for facilitating sale to a potential customer of an object (par. 0030) over a computer network (par. 0028); said object having a predetermined three-dimensional shape.

The method comprises, over the computer network, providing the potential customer with a display with a plurality of display icons (see Fig. 3; and par. 0033) representing different views (see par. 0033, last two lines) of a predetermined three-dimensional shape of an object (par. 0033);

over the computer network, providing the potential customer with a user input for a design element selected by the user to be included on said object at a first location on the object (par. 0036);

providing an input for said user to select any of said plurality of display icons (par. 0034); and

over the computer network, providing the potential customer with views of the object with the user selected design element on the object at the first location represented by the selected display icon, wherein said user inputs provide at least first and second different views of said object with the selected design element displayed thereon and viewable as selected (par. 0043).

Costin discloses that the display icons represent a plurality of different objects (see Fig. 3: "HARD JEANS, CARPENTER JEANS, WIDE LEG, BAGGY, LOOSE, RELAXED, REGULAR, BOOT CUT"; and teaching at par. 0033 that "[t]he picture that is provided corresponds generally to the selection"), including a plurality of different views for each object (see Fig. 3).

Costin discloses that the design element is user created text (par. 0052).

Costin discloses that the design element may be selected from among a plurality of design elements, where user selected text may be included in at least one of said plurality of design elements (par. 0052-0053: note that the design element comprises the user selected text as well as user selected font(s) and point(s)).

Costin discloses providing a user input for selecting among different portions of the object for placement of the design element (par. 0034).

Costin discloses providing a user input for ordering the object with the user selected design element and receiving a user order from said user input for ordering the object with the user selected design element (par. 0048).

Costin does not describe the views other than to say that "[t]he receiving computer provides the diagram shown in Fig. 5, which shows the front and back of the apparel on the screen" (par. 0033). Nonetheless, Costin is clear that the purpose of providing views is to allow the user to select areas on the views which represent the actual placement of user selected designs on the actual object. Such views permit a user to decide if he/she likes the look of the object thus modified and is thus satisfied (par. 0055).

Berger et al., in a similar method (col. 1, line 65-col. 2, line 28), discloses an icon representing a perspective view of a predetermined three-dimensional shape of one object with a selected design element displayed thereon (see Figs. 7-9).

It would have been obvious to one of ordinary skill in the art to have modified the multiple views of Costin to have included, specifically, perspective views (as of the type taught by Berger et al.) in order to have assisted potential customers in coming to a final determination on a customized design as the perspective views would have shown the finished object in a relatively accurate way. Such perspective views would have provided more information about the finished object to the potential customer--thereby eliminating "mistakes" that would have resulted had less information about the finished object been provided to the potential customer (see Berger et al.: col. 8, lines 20-29).

Regarding claims 19-23, and 25: See client/server arrangement in Fig. 1 and described at paragraphs 0026-0029.

Claims 5, 9, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin (US 2005/0131571 A1) and Berger et al. (U.S. Patent No. 6,414,693 B1) as applied to claims 3, 8, and 19, respectively, above, and further in view of Knight (U.S. Patent No. 6,344,853 B1).

Costin teaches facilitating the sale of garment or apparel objects. Costin, for example, teaches that his system and method can accommodate "literally every possibility of apparel that can be made at the manufacture's processing location" (par. 0029). Specifically, Costin discloses "jeans, shorts, shirts, jackets" (par. 0030).

Costin, however does not disclose facilitating the sale of a cap.

Now comes Knight. Knight teaches a method and system for facilitating the sale of a cap (col. 1, lines 7-22; and Figs. 3D-3F). Such cap is shown to include a crown and a visor (best seen in Fig. 3D).

It would have been obvious to one of ordinary skill in the art to have provided the combination of Costin and Berger et al. to have included the specification of a cap having a crown and a visor. Such cap would have represented one of the "literally every possibility of apparel" taught by Costin. Moreover, such cap is specifically taught by Knight as being a particular type of apparel both suitable and desirable for implementation in a method of the type disclosed by Costin (as modified by Berger et al.). See Knight at col. 1, lines 7-22.

Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin (US 2005/0131571 A1) in view of Berger et al. (U.S. Patent No. 6,414,693 B1) and Knight (U.S. Patent No. 6,344,853 B1).

Costin discloses a method for facilitating sale of an apparel object (par. 0030) over the Internet (par. 0028).

The method comprises, over the Internet, providing a user input for selecting at least one display icon from a plurality of display icons (see Fig. 3; and par. 0033), each of said display icons representing different views (see par. 0033, last two lines) of one apparel design offered for sale (par. 0033; and pars. 0047-0048);

over the Internet, providing a user input for a design element to be included on said apparel object (par. 0036); and

over the Internet, providing a display illustrating the cap represented by the selected display icon with the user created text at the user selected location on said apparel object (par. 0043).

Costin discloses that the design element is user created text (par. 0052).

Costin discloses that the design element may be selected from among a plurality of design elements, where user selected text may be included in at least one of said plurality of design elements (par. 0052-0053: note that the design element comprises the user selected text as well as user selected font(s) and point(s)).

Costin discloses providing a user input for selecting among different portions of the apparel object for placement of the design element (par. 0034).

Costin discloses providing a user input for ordering the apparel object with the user selected design element and receiving a user order from said user input for ordering the apparel object with the user selected design element (par. 0048).

Costin does not describe the views other than to say that "[t]he receiving computer provides the diagram shown in Fig. 5, which shows the front and back of the apparel on the screen" (par. 0033). Nonetheless, Costin is clear that the purpose of providing views is to allow the user to select areas on the views which represent the actual placement of user selected designs on the actual apparel object. Such views permit a user to decide if he/she likes the look of the object thus modified and is thus satisfied (par. 0055).

Berger et al., in a similar method (col. 1, line 65-col. 2, line 28), discloses an icon representing a perspective view of a predetermined three-dimensional shape of one object (see Figs. 7-9).

It would have been obvious to one of ordinary skill in the art to have modified the views of Costin to have included, specifically, perspective views (as of the type taught by Berger et al.) in order to have assisted users in coming to a final determination on a customized design as the perspective views would have shown the finished object in a relatively accurate way. Such perspective views would have provided more information about the finished object to the user--thereby eliminating "mistakes" that would have resulted had less information about the finished object been provided to the user (see Berger et al.: col. 8, lines 20-29).

The combination of Costin and Berger et al. is yet to provide that the apparel is a cap. Costin, however, and as noted above, teaches facilitating the sale of apparel objects. Costin, for example, teaches that his system and method can accommodate "literally every possibility of apparel that can be made at the manufacture's processing location" (par. 0029). Specifically, Costin discloses "jeans, shorts, shirts, jackets" (par. 0030).

Now comes Knight. Knight teaches a method and system for facilitating the sale of a cap (col. 1, lines 7-22; and Figs. 3D-3F). Such cap is shown to include a crown and a visor (best seen in Fig. 3D).

It would have been obvious to one of ordinary skill in the art to have further provided the combination of Costin and Berger et al. to have further included the specification of a cap having a crown and a visor. Such cap would have represented one of the "literally every possibility of apparel" taught by Costin. Moreover, such cap is specifically taught by Knight as being a particular type of apparel both suitable and desirable for implementation in a method of the type disclosed by Costin (as modified by Berger et al.). See Knight at col. 1, lines 7-22.

Response to Arguments

Applicant's arguments filed 9/28/2006 have been fully considered but they are not persuasive.

The Applicant argues that Costin does not teach or suggest the ability to view an applied design piece (and the associated object) from two different perspectives.

The Examiner notes, Berger not Costin was relied upon to show perspective views. Even though it is clear that Costin provides multiple views to a user, wherein such views permit a user to decide if he/she likes the look of an object (par. 0055). Berger et al. is used for its teaching (in an analogous environment) of providing perspective views, rather than the two-dimensional views disclosed by Costin. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It would have been obvious to one of ordinary skill in the art to have modified the multiple views of Costin to have included, specifically, perspective views (as of the type taught by Berger et al.) in order to have assisted potential customers in coming to a final determination on a customized design as the perspective views would have shown the finished object in a relatively accurate way. Such perspective views would have provided more information about the finished object to the potential customer--thereby

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eliminating "mistakes" that would have resulted had less information about the finished object been provided to the potential customer (see Berger et al.: col. 8, lines 20-29). It is clear that Berger enables end users to view completed bags with desired graphics thereon quickly, easily and in a large number of variations.

The Applicant further argues that if one skilled in the art combined Berger's teachings with Costin, one would still have only a system wherein an object with the design element at any location would be viewable from only a single perspective.

The Examiner respectfully disagrees; Berger provides a system and method for enabling the custom design and ordering of large number of articles in an Internet or other computer-based environment. These articles should allow an ordering client to be able to manipulate and view the finished article with a reasonably good degree of accuracy and clarity.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S Gart whose telephone number is (571) 272-3955. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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msg


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